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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,118	10/12/2001	Tohgo Murata	700-286	1739

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EXAMINER

CHENG, JOE H

ART UNIT PAPER NUMBER

3713

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,118

Applicant(s)

MURATA ET AL.

Examiner

Joe H. Cheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/11/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, all of the claimed method steps, *inter alia*, configuring a software program with a plurality of English sentences, parsing the English sentence into a plurality of predefined English sentence parts, entering each of said predefined English sentence parts into a corresponding input field of a computer program user interface, and presenting the student with the user interface of the software program, and the claimed structural elements, *inter alia*, the “computer processing means”, “the user interface of the software program”, “a display field of the user interface”, “visual aided field”, and “the database of all sentence entries”, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

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2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The references for method steps of the “configuring a software program with a plurality of English sentences”, “parsing the English sentence into a plurality of predefined English sentence parts”, “entering each of said predefined English sentence parts into a corresponding input field of a computer program user interface”, “concatenate the plurality of input fields to provide a resultant English sentence field for display to a user”, “presenting the student with the user interface of the software program”, “displaying to the student in a display field of the user interface the entirety of the sentence part contained by the selected input field”, “displaying to the student in a sentence display field the concatenated sentence parts obtained from each of the input field for the selected sentence” (as per claim 1), the “computer program user interface”, “the user interface of the software program”, the “display field of the user interface” (as per claim 1 and 20), “calculating the number of occurrences of each different sentence part input thereto”, “displaying the calculation results for the input field selected by the student” (as per claims 5 and 24), “configured with store a visual aid file in a field associated with each sentence entered”, “a visual aid file” (as per claims 11 and 30), “the static image file” (as per claims 12 and 31), the “animated image file” (as per claims 13 and 32), “configured with store an audio aid file in a field associated with each sentence entered” (as per claims 15 and 33), the “audio aid file” (as per claims 15, 16 and 33), “configured with store a comment file in a field associated with each sentence entered”, the “comment file” (as per claims 17 and 34),

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“providing the student with a filter utility”, the “filter utility”, the database of all sentence entries based on a filter criteria selected by the student, the “filter criteria” (as per claims 18 and 35), “providing the student with a calculation utility”, “the calculation utility” (as per claims 19 and 36), “the computer processing means to store a plurality of English sentences and predefined sentence parts into a plurality of input fields of a computer program”, “display to the student the user interface of the software program”, “display to the student in a display field of the user interface the entirety of the sentence part contained by the selected input field”, “display to the student in a sentence display field the concatenated sentence parts obtained from each of the input field for the selected sentence” and “the input means” (as per claim 20) are unclear. In addition, the antecedent basis for “the computer program”, “the user interface of the **software** program” (as per claims 1 and 20), the “sentence phrase” (as per claims 4 and 23), “the database of all sentence entries based on a filter criteria” (as per claims 18 and 35) has not been clearly set forth. Further, it appeared that applicant is intended to claimed the Markush groups, people (p), things (t), abstract words (a), pronouns (r), or interrogative (as per claims 6 and 25); verb as an existence of a subject (b), verb for action (v), adjective to express a state of a subject (j), people (p), things (t), abstract words (a), or pronouns (r) (as per claims 7 and 26); people (p), things (t), abstract words (a), pronouns (r), or object complement such as verb, adjective, noun or pronoun (as per claims 8 and 27); place (wr), time (wn), reason (wy), method (hw), if (if), by, with, for and so on (as per claims 9 and 28); there is/ here is (there), interjection (int), adverb word, phrase, or clause (adv), conjunction (conj), relative pronoun (rp), interrogative words (wh), or auxiliary verb (ax) (as per claims 10 and 29) are improper. It is suggested that when materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in

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the conventional manner or alternatively, for example, “wherein ... is ... selected from the group consisting of ... and ...” or “wherein ... is ... or ...” is a proper limitation and is considered proper. See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925) and MPEP § 2173.05(h)). Furthermore, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). Hence, the phrases “such as” (as per claims 8 and 27), “and so on” (as per claims 9 and 28), and “there is/ here is” (as per claims 10 and 29) render the claim indefinite because they are unclear whether the limitation(s) following the phrase are part of the claimed invention and they are alternate expressions and are subject to more than one interpretation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1 –4 and 6-18 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Steele et al (U.S. Pat. No. 5,169,342). The broadly claimed structure can be interpreted as the method of communicating with a language deficient patient of Steele et al. The teaching of Steele et al broadly discloses the method of using a computer to instruct a student to learn the English language by configuring a software program or spreadsheet program with a plurality of English sentences which being entered by parsing the English sentence into a plurality of predefined English sentence parts (see Figs. 12a-12c), wherein the predefined English sentence parts comprising the subject having people or thing, predicate having verb, or adjective, or pronouns, object having people or thing, condition having place or time, and pre-subject having interjection or conjunction, entering each of the predefined English sentence parts into a corresponding input field of a computer program user input interface (F of Fig. 1), wherein the computer program is adapted to display each input field for each sentence entered and concatenate the plurality of input fields to provide a resultant English sentence for display to a user (G of Fig. 1), presenting the student with the user input interface of the software program to allow the student to select any of the input field with the input device (D of Fig. 1), the student selecting a desired input field for a desired sentence entry, displaying to the student in a display field of the user interface the entirety of the sentence part contained by the selected input field, displaying to the student in a sentence display field the concatenated sentence parts obtained from each of the input field for the selected sentence (see Fig. 13g), wherein the software is configured to store a visual aid file having the animated image file and audio aid file (see Figs. 14a—14i).

Claim Rejections - 35 USC § 103

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 20-23 and 25-35 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Steele et al (U.S. Pat. No. 5,169,342) in view of Rehbein et al (U.S. Pat. No. 6,685,188 B2). It is noted that the teaching of Steele et al does not specifically disclose the housing suitable for being held in the hand (as per claim 20) as required. However, the teaching of Rehbein et al broadly discloses the housing suitable for being held in the hand (11). Hence, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Steele et al with the feature of the hand held housing as taught by Rehbein et al as both Steele et al and

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Rehbein et al are directed to the apparatus, so as to provide a hand held device for instructing a student to learn the different type of language.

9. Claims 5, 19, 24 and 36 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Steele et al (U.S. Pat. No. 5,169,342) in view of Rehbein et al (U.S. Pat. No. 6,685,188 B2) and further in view of Hillis et al (U.S. Pub. No. 2005/0086188 A1). It is noted that the teachings of Steele et al and Rehbein et al do not explicitly disclose the calculation utility (as per claims 19 and 36) to provide the number of occurrences of the sentence part input thereto (as per claims 5 and 24) as required. However, the teaching of Hillis et al broadly discloses the calculation utility to provide the number of occurrences of the sentence part input thereto (see Fig. 12, and item 314, and see paragraph 0362). Hence, it would have been obvious to one of ordinary skill in the art to modify the method and apparatus of Steele et al and Rehbein et al with the feature of the calculation utility to provide the number of occurrences of the sentence part input thereto as taught by Hillis et al as both Steele et al, Rehbein et al and Hillis et al are directed to the method and apparatus for instructing a student to learn the English language, so as to improve the student's learning skill of the English language.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Holtz (U.S. Pat. No. 4,366,551) - note Figs. 1-16;

Hiramatsu et al (U.S. Pat. No. 4,786,255) - note Figs. 1-4E;

Knowles et al (U.S. Pat. No. 5,065,345) - note Figs. 1-3;

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Su et al (U.S. Pat. No. 5,418,717) - note Figs. 1-10B;
Stuckey (U.S. Pat. No. 5,721,938) - note Figs. 1-5;
Maruta (U.S. Pat. No. 5,868,576) - note Figs. 1-26;
Guinan (U.S. Pat. No. 6,022,222) - note Figs. 1-25;
Shieber et al (U.S. Pat. No. 6,138,098) - note Figs. 1-15;
Weise (U.S. Pat. No. 6,275,791 B1) - note Figs. 1-13b;
Hu et al (U.S. Pub. No. 2001/0014902 A1) - note Figs. 1-4;
Walker (U.S. Pat. No. 6,279,017 B1) - note Figs. 1-27;
Armstrong (U.S. Pat. No. 6,314,411 B1) - note Figs. 1-19;
Brandon et al (U.S. Pat. No. 6,385,568 B1) - note Figs. 1 and 2;
Ati-Mokhtar et al (U.S. Pub. No. 2002/0116169 A1) - note Figs. 1-5;
Menezes et al (U.S. Pub. No. 2003/0061023 A1) - note Figs. 1-8;
Lundquist (U.S. Pub. No. 2003/0157467 A1) - note Figs. 1-7;
Wakefield et al (U.S. Pat. No. 6,732,097 B1) - note Figs. 1-13;
Moore (U.S. Pub. No. 2004/0098247 A1) - note Figs. 1-11;
Au (U.S. Pat. No. 6,778,970 B2) - note Figs. 1-95;
Binning et al (U.S. Pat. No. 6,792,418 B1) - note Figs. 1-11;
Hatton (U.S. Pub. No. 2004/0215443 A1) - note Fig. 1;
Rehbein et al (U.S. Pub. No. 2005/0017453 A1) - note Figs. 1-21;
Kuhn et al (U.S. Pat. No. 6,901,366 B1) - note Figs. 1-3;
Koizumi et al (Japanese Pat. No. JP3-81794 A) - note Figs. 1-14;
Murata et al (Japanese Pat. No. JP 2003-173136A) - note Figs. 1-6.

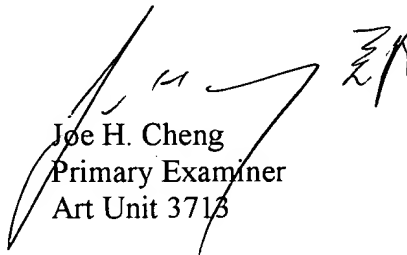
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (571)272-4433. The examiner can normally be reached on Tue - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joe H. Cheng
May 18, 2005


Joe H. Cheng
Primary Examiner
Art Unit 3713